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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,873	11/05/2003	Diana Amelia Normington	2003-22	6238
32246	7590	09/06/2005	EXAMINER	
PETER J.C. NORMINGTON 516 COUNTRY PLAZA SOUTH GILBERT, AZ 85234			BLAKE, CAROLYN T	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/701,873

Applicant(s)

NORMINGTON, DIANA AMELIA

Examiner

Carolyn T. Blake

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5, 9-12, 16, 17, 20, 23, 25, 26 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 9-12, 16, 17, 20, 23, 25, 26 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 17, 2005 has been entered.

Drawings

2. The drawings are objected to because the removal of the hinge in FIGS 1 and 2 constitutes new matter.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Art Unit: 3724

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The amendment filed August 17, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in the second paragraph of the amendment, it is disclosed the bottom portion of the device is fixed, but could be manufactured using a snap connection. In the original specification, the bottom portion is disclosed as hinged, and no mention is made of a snap connection.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 2, 5, 9, 11, 12, 16, 17, 20, 23, 25, and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the second paragraph of the amendment, it is disclosed the bottom portion

Art Unit: 3724

of the device is fixed, but could be manufactured using a snap connection. In the original specification, the bottom portion is disclosed as hinged, and no mention is made of a snap connection.

Claim Rejections - 35 USC § 102

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 30 is rejected under 35 U.S.C. 102(b) as being anticipated by Farmwald et al (2,816,608).

Farmwald et al disclose an adjustable apparatus (28) that can be added to existing decorative punches comprising: said adjustable apparatus (45) acts as a stop to a moveable cutting die (30) containing a punch pattern thereby limiting the amount of said punch pattern cut into a sheet of material being punched; said moveable cutting die (30) is designed with a curved cutting surface so that said adjustable apparatus (45) can limit the amount of paper cut by that cutting surface, said adjustable apparatus (45) can be moved to a position so that said designed pattern of said punch is cut fully out of said sheet of material, and said adjustable apparatus (45) can be permanently installed on existing decorative punches.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 3724

10. Claims 1, 2, 5, 9, 10, 11, 12, 16, 17, 20, 23, 25, 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (5,749,278) in view of Snow (132,544).

Lee et al disclose a machine for piercing sheets substantially as claimed, but fail to disclose an adjustable apparatus. Snow discloses a machine for piercing sheets (see especially FIG 3) comprising an adjustable apparatus (h) that acts as a stop to a moveable cutting element (D) thereby varying an amount of material cut; and the adjustable apparatus (h) is an externally threaded piece of hardware located in a matching threaded insert attached to the frame such that said externally threaded piece of hardware can be rotated within said threaded insert moving said threaded piece of hardware up and down thereby adjusting and controlling the amount of travel of the cutting element. The adjustable apparatus varies the amount the work piece is cut. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an adjustable apparatus, as disclosed by Snow, on the Lee et al device for the purpose of varying the amount the work piece is cut.

Response to Arguments

11. Applicant's arguments with respect to claim 30 have been considered but they are not persuasive.

Regarding the argument the Farmwald et al device is not a "decorative punch," this term is not limited to the type of punch disclosed by Applicant. The Farmwald et al punch could be used to punch holes for the purpose of creating a pattern or providing an ornamental element. Accordingly, the Farmwald et al device is a decorative punch.

Regarding the argument the adjustment device in the Farmwald et al device cannot be added to decorative punches, Applicant is again reminded of the broad range of punches capable of use for decorative purposes. Clearly, an adjustment device was installed on the Farmwald et al device, so it was added as such. In addition, the adjustment device could find utility in other types of punches.

12. According to Applicant, Examiner noted the slot of the claimed invention is fixed. This is incorrect; Examiner pointed out that the slot of Applicant's device is fixed during a punching operation. The slot is not fixed as claimed, and is capable of rotating on the hinge in order to withdraw a work piece.

13. Applicant's arguments with respect to the remaining claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McWilliams (143,023), Stimpson (678,781), and Pace (1,806,704) disclose cutting machines with an adjustable apparatus.

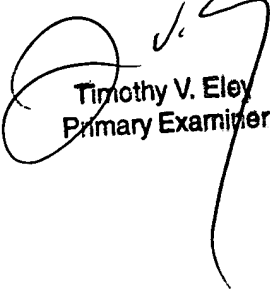
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CB
September 1, 2005



Timothy V. Eley
Primary Examiner